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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91196246
Party	Plaintiff TeraMedica, Inc.
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)	
TeraMedica, Inc.,)	Opposition No. 91196246
)	
Opposer,)	Application No. 77/948,212
)	Mark: TERRAMEDICA
v.)	Filed: March 2, 2010
)	
TerraMedica LLC,)	Application No. 77/948,424
)	Mark: TERRAMEDICA & Design
Applicant.)	Filed: March 2, 2010
)	

Opposer, TeraMedica, Inc., answers Applicant's Counterclaim as follows:

Answer: Opposer admits that it is the owner of Registration Nos. 2678899, 3585921 and 3585922.

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inquiry as to purchasing Applicant's URL, prior to its own use in commerce or in connection with any goods or services, and based on Applicant's current services being within the natural zone of expansion of its services from prior to Opposer's use of TERAMEDICA, either anywhere or in commerce, then in the alternative, Applicant alleges that Opposer's marks, when used on Opposer's goods and services, are likely to cause confusion, or to cause mistake, or to deceive relative to Applicant's marks.

Answer: Opposer denies that Applicant used TERRAMEDICA as a trademark prior to Opposer's use of TERAMEDICA as a trademark, and therefore denies the allegations set forth in Paragraph 2.

3. Applicant's TerraMedica.com URL was created on November 22, 1999 (see Exhibit 1 to the Answer).

Answer: Opposer admits that the URL terramedica.com was created on November 22, 1999. As to Applicant's ownership of the URL on that date, Opposer is without knowledge or information sufficient to form a belief as to the truth of that allegation and therefore denies it.

4. Applicant TerraMedica submitted a business plan to the GopherTheGold Business Plan Competition on April 3, 2000 (see Exhibit 2 to the Answer).

Answer: Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 4 and therefore denies them.

5. A summary of the Internet Archive Waybackmachine shows the snapshots archived for Applicant's www.TerraMedica.com website from at least as early as April 21, 2001 (see Exhibit 3 to the Answer).

Answer: Opposer admits that the Internet Archive Wayback Machine features archived pages from the website www.terramedica.com dating back to April 21, 2001. As to Applicant's

ownership of the website on that date or any date after April 21, 2001, Opposer is without knowledge or information sufficient to form a belief as to the truth of that allegation and therefore denies it.

6. Applicant TerraMedica used the mark TERRAMEDICA to advertise and promote services related to services for health care finance and services for insurers on its website at least as early as April 21, 2001 (see Exhibit 4 to the Answer, a snapshot of the TerraMedica.com website dated April 21, 2001) and the link entitled Clinically based risk profiling for insurers (see Exhibit 5 to the Answer, a snapshot of the page linked to “See the cost-savings of Terramedica’s case mix methods” on the home page of April 21, 2001. See also Exhibit 6 to the Answer, the page linked to “Medical Demand Groups (MDGs)” on Exhibit 5.

Answer: Opposer is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 6 and therefore denies them.

7. Opposer Teramedica’s own website states that Teramedica was formed in 2001 (see Exhibit 7 to the Answer).

Answer: Opposer admits that its website states that TeraMedica Healthcare Technology, a privately held company, was formed in 2001, but the use of the TeraMedica name dates back to the company’s origins in July 2000, and indeed TeraMedica was formed in July 2000 and incorporated in September 2000.

8. A D&B report for Opposer Teramedica confirms that it was started in 2001 (see Exhibit 8 to the Answer).

Answer: Opposer denies the allegations in Paragraph 8.

9. An article from the Milwaukee Journal Sentinel on July 15, 2001 supports the assertion that Opposer Teramedica was formed in 2001 (see Exhibit 9 to the Answer).

Answer: Opposer denies the allegations in Paragraph 9.

10. An Experian report supports the assertion that Opposer Teramedica was formed in 2001 (see Exhibit 10 to the Answer).

Answer: Opposer denies the allegations in Paragraph 10.

11. The Opposer's Teramedica.com URL was created on November 16, 2001 (see Exhibit 11 to the Answer).

Answer: Opposer admits the allegations in Paragraph 11.

12. A summary of the Internet Archive Waybackmachine shows the snapshots archived for Opposer's www.Teramedica.com website starting on November 28, 2001 (see Exhibit 12 to the Answer).

Answer: Opposer admits the allegations in Paragraph 12.

13. On information and belief, sometime between the creation of Applicant TerraMedica's URL on November 22, 1999 and Opposer Teramedica's URL on November 16, 2001, a person associated with or in privity with what would become Teramedica, called Steven Parente, who was identified in Exhibit 1 to the Answer, which also provided a phone number for Steven Parente, to inquire about the plans for TerraMedica's website, as well as to inquire as to whether the www.TERRAMEDICA.com URL was for sale.

Answer: Opposer denies the allegations in Paragraph 13.

14. On information and belief, Opposer Teramedica was aware of the existence of Applicant's Terramedica.com URL and its service mark usage, and selected its name Teramedica and its URL www.teramedica.com with full knowledge of TerraMedica's name and URL, to avoid a conflict with TerraMedica.

Answer: Opposer denies the allegations in Paragraph 14.

15. The Notice of Opposition is barred by laches.

Answer: Opposer denies the allegations in Paragraph 15.

16. The Notice of Opposition is barred by estoppel.

Answer: Opposer denies the allegations in Paragraph 16.

17. The Notice of Opposition is barred by acquiescence.

Answer: Opposer denies the allegations in Paragraph 17.

18. The Notice of Opposition is barred by waiver.

Answer: Opposer denies the allegations in Paragraph 18.

19. Applicant's marks are substantially different in sound, appearance, connotation and overall commercial impression to Opposer's alleged TERAMEDICA Marks.

Answer: Opposer denies the allegations in Paragraph 19.

20. Applicant's services "fraud detection services in the field of health care insurance" in International Class 45, are not confusingly similar as compared to Opposer's services, "Computer services, namely, data migration, installation and configuration of software used for managing the storage and serving of digital images of others; technical support services, namely, troubleshooting of computer software that manages the storage and serving of digital images for others" in International Class 042.

Answer: Opposer denies the allegations in Paragraph 20.

21. Applicant's services are promoted in different channels of trade and to different consumers as compared to Opposer's goods and services.

Answer: Opposer denies the allegations in Paragraph 21.

22. Applicant's services "fraud detection services in the field of health care insurance" are within the natural zone of expansion of its services from prior to Opposer's use in commerce.

Answer: Opposer denies the allegations in Paragraph 22.

23. The Notice of Opposition is barred because, on information and belief, Opposer's registrations were obtained fraudulently, in that Opposer knowingly made a false, material representation of fact in connection with Reg. Nos. 2678899, 3585921 and 3585922, when Opposer stated that "to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive" in the trademark applications.

Answer: Opposer denies the allegations in Paragraph 23.

24. The Notice of Opposition is barred because, on information and belief, Opposer's Registration No. 3585922 was obtained fraudulently, in that Opposer knowingly made a false, material representation of fact in connection with Reg. No. 3585922, when Opposer asserted a date of first use of the mark of August 25, 2000 and/or when Opposer asserted a date of first use of the mark in commerce of November 1, 2000, in an attempt to obtain priority over Applicant's prior usage of TERRAMEDICA, which Opposer had knowledge of, and when one or both of which dates are prior to when Opposer was even formed, and/or prior to its first use of TERAMEDICA stylized in commerce in connection with any class 9 goods and/or class 42 services, and/or also prior to the date of first use of software asserted to be in commerce at least as early as June 18, 2002 in the application of Reg. No. 2678899, which was filed June 7, 2001.

Answer: Opposer denies the allegations in Paragraph 24.

25. Registration 2678899 for the mark TERAMEDICA covers "COMPUTER HARDWARE AND SOFTWARE FOR PROCESSING MEDICAL IMAGING FOR USE BY HOSPITALS AND DOCTORS" in International Class 010.

Answer: Opposer admits the allegations in Paragraph 25.

26. Registration 3585921 for the mark TeraMedica and Design covers “Software that manages the storing and serving of digital images” in International Class 009 and “Computer services, namely, data migration, installation and configuration of software used for managing the storage and serving of digital images of others; technical support services, namely, troubleshooting of computer software that manages the storage and serving of digital images for others” in International Class 042.

Answer: Opposer admits the allegations in Paragraph 26.

27. Registration 3585922 for the mark TeraMedica (stylized) covers “Software that manages the storing and serving of digital images” in International class 009 and “Computer services, namely, data migration, installation and configuration of software used for managing the storage and serving of digital images of others; technical support services, namely, troubleshooting of computer software that manages the storage and serving of digital images for others” in International class 042.

Answer: Opposer admits the allegations in Paragraph 27.

28. On information and belief, at the time of filing of the applications which matured as Reg. Nos. 2678899, 3585921 and 3585922, Opposer was aware of another person who had the right to use a mark in commerce in a form in such near resemblance to the form of the applications, as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Answer: Opposer denies the allegations in Paragraph 28.

29. Accordingly, on information and belief, Opposer fraudulently obtained Reg. Nos. 2678899, 3585921 and 3585922.

Answer: Opposer denies the allegations in Paragraph 29.

30. On information and belief, Opposer's Registration No. 3585922 was obtained fraudulently, in that Opposer knowingly made a false, material representation of fact in connection with Reg. No. 3585922, when Opposer asserted a date of first use of the mark of August 25, 2000 and/or when Opposer asserted a date of first use of the mark in commerce of November 1, 2000, one or both of which dates are prior to when Opposer was even formed, and/or prior to its first use of TERAMEDICA stylized in commerce in connection with any class 9 goods and/or class 42 services, and/or also prior to the date of first use of software asserted to be in commerce at least as early as June 18, 2002 in the application of Reg. No. 2678899, which was filed June 7, 2001.

Answer: Opposer denies the allegations in Paragraph 30.

31. Accordingly, on information and belief, Opposer fraudulently obtained Reg. No. 3585922.

Answer: Opposer denies the allegations in Paragraph 31.

32. Opposer has opposed Applicant's applications 77/948212 and 77/948424 based on Registration Nos. 2678899, 3585921 and 3585922.

Answer: Opposer admits the allegations in Paragraph 32.

33. Therefore, Applicant is likely to be damaged by the continued registration of Registration Nos. 2678899, 3585921 and 3585922.

Answer: Opposer denies the allegations in Paragraph 33.

AFFIRMATIVE DEFENSES

First Affirmative Defense

Applicant's counterclaim fails to state a cause of action upon which relief can be granted.

Second Affirmative Defense

Applicant fails to plead its claim of fraud with particularity pursuant to Fed. R. Civ. P.

9(b).

Third Affirmative Defense

Applicant's counterclaim is barred by the doctrine of estoppel, laches, waiver, unclean hands, and/or other equitable considerations.

Respectfully submitted,

TERAMEDICA, INC.

By its Attorneys,

Date: November 29, 2010

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CERTIFICATE OF MAILING AND SERVICE

I hereby certify that a true and correct copy of the foregoing Answer to Applicant's Counterclaim is being served upon Applicant's Attorney of Record via First Class Mail and email:

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and that a copy of the same was filed electronically on the same date via ESTAA with the Trademark Trial and Appeal Board.

November 29, 2010

/Laura M. Konkel/

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